

Notice of Allowability	Application No.	Applicant(s)	
	10/664,732	LAL GUPTA, SHANKER	
	Examiner	Art Unit	
	Michael C. Henry	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/11/05.
2. ☒ The allowed claim(s) is/are 1-5, 8-12, 14-21, 24-28, 30-38, 41-47, and 49-114. These claims are renumbered 1-105, respectively.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>09/18/03</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

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Reasons For Allowance

The following is an examiner's statement of reasons for allowance: The examiner has found claims 1-5, 8-12, 14-21, 24-28, 30-38, 41-47, and 49-114 to be unobvious over the prior art of record and therefore to be allowable over the prior art of record. The present invention relates to boronic acid compounds of a given formula and their method of preparation. The very relevant prior art documents (US 5,106,948, US 5,169,841) to this invention discloses boronic acid compounds of a given formula and their method of preparation. However, the compounds of the present invention possess structural differences (like amino acids and sugar) that are unobvious to those of the prior art. Also, their methods of preparation are different and unobvious to those of the prior art. Furthermore, the provisional double patenting rejection of the prior office action, which was made over applicant's patent US 6,713,446, is presently overcome or rendered moot, due to applicant's timely filed terminal disclaimer in the instant invention. The provisional double patenting rejection of the prior office action, which was made over applicant's patent US 6,699,835, is presently overcome or rendered moot, due to applicant's arguments in response, filed 05/11/05.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Henry whose telephone number is 703 308-7307.


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The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703 308-4624. The fax phone number for the organization where this application or proceeding is assigned is 703 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

MCH

May 27, 2005.



ELVIS O. PRICE, PH.D.
PRIMARY EXAMINER

DETAILED ACTION

Claims 1-5, 8-12,14-21,24-28,30-38,41-47 and 49-114 are pending in application

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 8-12,14-21,24-28,30-34, 55-66, 72-84, 86-102, 109-114 are rejected under the judicially created doctrine of double patenting over claims 1-32 of U. S. Patent No. 6,699,835 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: In claim 1, applicant claims "a compound of the formula (I) wherein R⁵ in each instance, is aryl, aralkyl, alkaryl,". Dependent claims, 2-5,8-12,14-21, 24-28 and 30-34 are further limitations of the compound of formula (I).

In claim 1, Plamondon et al. claims "a compound having the formula (I) wherein R⁵ in each instance, is one of aryl, aralkyl, alkaryl,".

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The difference between applicant's claimed compound and the compound of Plamondon et al. is that applicant compound of formula (I) is not limited to species in which R^5 in each instance is only one particular moiety such as aryl, aralkyl or alkaryl but encompasses species wherein R^5 in each instance, is not only one particular moiety.

It would have been obvious to one having ordinary skill in the art, at the time the claimed invention was made to have prepared a compound of formula (I) that is not limited to species in which R^5 in each instance is only one particular moiety such as aryl, aralkyl or alkaryl, since Plamondon et al. disclose that R^5 can be of the said claimed moieties.

One having ordinary skill in the art would have been motivated, to prepare a compound of formula (I) that is not limited to species in which R^5 in each instance is only one particular moiety such as aryl, aralkyl or alkaryl, since Plamondon et al. disclose that R^5 can be of the said claimed moieties.

Claims 35-54, 67-71, 85, 103-108 are rejected under the judicially created doctrine of double patenting over claims 33-50 of U. S. Patent No. 6,699,835 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: In claim 35, applicant claims "a method of preparing a lyophilized compound of formula (1)" Dependent claims, 36-54 are further limitations of the compound of formula (I).

Claim 33 of Plamondon et al. is drawn to "a method for formulating a boronic acid compound which is lyophilized.

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The difference between applicant's claimed method and the method of Plamondon et al. is that applicant claims specific boronic compounds of formula (I) and compounds that have hydroxyl groups and are derived from sugar.

It would have been obvious to one having ordinary skill in the art, at the time the claimed invention was made to claim specific boronic compounds of formula (I) and compounds that have hydroxyl groups and are derived from sugar to prepare the said lyophilized compound, since Plamondon et al. disclose that said compounds of the genus can be used to prepare the lyophilized.

One having ordinary skill in the art would have been motivated, to claim specific boronic compounds of formula (I) and compounds that have hydroxyl groups and are derived from sugar to prepare the said lyophilized compound, since Plamondon et al. disclose that said compounds of the genus can be used to prepare the lyophilized compound.

Claims 1-5, 8-12,14-21,24-28,30-34, 55-66, 72-84, 86-102, 109-114 are rejected under the judicially created doctrine of double patenting over claims 1-22, 38-49,54-66,,68-84 and 89-92 of U. S. Patent No. 6,713,446 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: In claim 1, applicant claims "a compound of the formula (I) wherein Z^1 and Z^2 together form a moiety derived from a sugar" Dependent claims, 2-5,8-12,14-21, 24-28 and 30-34 are further limitations of the compound of formula (I).

In claim 1, Gupta claims "a compound having the formula (I) wherein the sugar is mannitol."

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The difference between applicant's claimed compound and the compound of Gupta is that applicant compound of formula (I) claims sugar but not a particular sugar like mannitol.

It would have been obvious to one having ordinary skill in the art, at the time the claimed invention was made to have prepared a compound of formula (I) that is not limited to any particular sugar, since Gupta claims that sugar can be the said moiety.

One having ordinary skill in the art would have been motivated, to prepare a compound of formula (I) that is not limited to any particular sugar, since Gupta claims that sugar can be the said moiety.

Claims 35-54, 67-71, 85, 103-108 are rejected under the judicially created doctrine of double patenting over claims 23-37, 50-53, 67, 85-88 of U. S. Patent No. 6,713,446 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: In claim 35, applicant claims "a method of preparing a lyophilized compound of formula (I)" Dependent claims, 36-54 are further limitations of the compound of formula (I).

Claim 23 of Gupta is drawn to "a method for formulating a boronic acid compound which is lyophilized.

The difference between applicant's claimed method and the method of Gupta is that applicant claims a sugar as a component in the preparation of said formulation whereas Gupta claims the specific sugar, mannitol.

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It would have been obvious to one having ordinary skill in the art, at the time the claimed invention was made to claim a sugar to prepare the said lyophilized compound, since Gupta disclose that said compounds of the genus can be used to prepare the lyophilized formulation.

One having ordinary skill in the art would have been motivated, to claim a sugar to prepare the said lyophilized compound, since Gupta disclose that said compounds of the genus can be used to prepare the lyophilized formulation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Henry whose telephone number is 571-272-0652. The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

MCH

November 22, 2004.